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|---|-------------|------------------------|---------------------|------------------|
| 10/647,745  | 08/25/2003  | Ronald William Lodholz | 9381.2              | 2296             |
| 20792   | 7590        | 02/08/2005             | EXAMINER            |                  |
| MYERS BIGEL SIBLEY & SAJOVEC<br>PO BOX 37428<br>RALEIGH, NC 27627 |             |                        |                     | REESE, DAVID C   |
|   |             | ART UNIT               |                     | PAPER NUMBER     |
|   |             | 3677                   |                     |                  |

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                 |                         |  |
|-----------------|-------------------------|--|
| Application No. | 10/647,745              |  |
| Examiner        | LODHOLZ, RONALD WILLIAM |  |
| David C. Reese  | Art Unit<br>3677        |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 25 August 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-49 is/are pending in the application.

4a) Of the above claim(s) 39-49 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Status of Claims***

### ***Election/Restrictions***

[1] Claims 39-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of forming a jewelry piece, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/26/2005. Thus, Claims 1-38 are pending.

### ***Claim Rejections - 35 USC § 102***

[2] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[3] Claims 1, 7-9, 12-13 16-17, 23-25, 28-29, 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins, US-4,488,415.

Jenkins teaches of an article of decorative jewelry.

As for Claim 1, Jenkins teaches of an article of decorative jewelry comprising:

a)

1) a base member (12 in Fig. 2) defining a base cavity (inside of 12 in Fig. 2) and having first (12 in Fig. 2) and second opposed ends (8 in Fig. 2), the base member tapering from the first end to the second end (20 tapering downward in Fig. 3) and defining a base opening in the first end (12 in Fig. 2); and

2) a bezel member (16 in Fig. 2) mounted on the first end of the base member (16 mounted to 12 via 14 in Fig. 2) and defining a bezel opening (16 in Fig. 2);  
3) wherein the bezel member is bonded to the first end of the base member (16 mounted to 12 via 14 in Fig. 2); and

b) a gemstone (4 in Fig. 5) mounted in the gemstone mount assembly (Fig. 5) and captured between the base member and the bezel member (4 between 20 and 16), wherein the gemstone is received in the base cavity (4 is received in 20) and extends through the base opening and the bezel opening (extends outside of both 20 and the bezel opening 16 as shown in Fig. 4).

As for Claim 7, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, wherein the base member has an outer shape that is substantially conical or frusto-conical (12 in Fig. 3).

As for Claim 8, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, wherein the base member has an outer shape that is substantially pyramidal or frusto-pyramidal (12 in Fig. 3).

As for Claim 9, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, wherein the base opening is substantially oval (10 in Fig. 1).

As for Claim 12, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, including a decorative embossment defined in an outer surface of the base member (decorative spaces between vertical segments 8 in Fig. 2).

As for Claim 13, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, including a decorative cutout defined in an outer surface of the base member and communicating with the base cavity (decorative cutouts between vertical segments 8 in Fig. 2).

As for Claim 16, Jenkins teaches of an article of decorative jewelry, Re: Claim 1, wherein the gemstone (4 in fig. 5) includes a base portion disposed in the base cavity (Fig. 5), a crown extending through and beyond the bezel member opposite the base member (4 in Fig. 4), and a girdle disposed between the bezel member and the base member (the sides of the stone disposed between both 20 and 16 in Fig. 4).

Jenkins teaches of an article of decorative jewelry.

As for Claim 17, Jenkins teaches of an assembly for use with a decorative stone comprising:

a) a base member (12 in Fig. 2) defining a base cavity (inside of 12 in Fig. 2) and having first (12 in Fig. 2) and second opposed ends (8 in Fig. 2), the base member

tapering from the first end to the second end (20 tapering downward in Fig. 3) and defining a base opening in the first end (12 in Fig. 2); and

- b) a bezel member (16 in Fig. 2) mounted on the first end of the base member (16 mounted to 12 via 14 in Fig. 2) and defining a bezel opening (16 in Fig. 2);
- c) wherein the bezel member is bonded to the first end of the base member (16 mounted to 12 via 14 in Fig. 2); and
- d) wherein the base member (12 in Fig. 2) and the bezel member (16 in Fig. 2) are adapted to capture the gemstone (Fig. 5) therebetween such that the gemstone is received in the base cavity (4 in 20 in Fig. 5) and extends through the base opening and the bezel opening (4 in Fig. 4).

As for Claim 23, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, wherein the base member has an outer shape that is substantially conical or frusto-conical (12 in Fig. 3).

As for Claim 24, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, wherein the base member has an outer shape that is substantially pyramidal or frusto-pyramidal (12 in Fig. 3).

As for Claim 25, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, wherein the base opening is substantially oval (10 in Fig. 1).

As for Claim 28, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, including a decorative embossment defined in an outer surface of the base member (decorative spaces between vertical segments 8 in Fig. 2).

As for Claim 29, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, including a decorative cutout defined in an outer surface of the base member and communicating with the base cavity (decorative cutouts between vertical segments 8 in Fig. 2).

As for Claim 32, Jenkins teaches of an article of decorative jewelry, Re: Claim 17, wherein the gemstone (4 in fig. 5) includes a base portion disposed in the base cavity (Fig. 5), a crown extending through and beyond the bezel member opposite the base member (4 in Fig. 4), and a girdle disposed between the bezel member and the base member (the sides of the stone disposed between both 20 and 16 in Fig. 4).

As for Claim 33, Jenkins teaches of an article of decorative jewelry comprising:

- a) a gemstone mount assembly including (Fig. 4):
  - 1) a base member (12 in Fig. 2) defining a base cavity (inside of 12 in Fig. 2) and having first (12 in Fig. 2) and second opposed ends (8 in Fig. 2), the base member tapering from the first end to the second end (20 tapering downward in Fig. 3) and defining a base opening in the first end (12 in Fig. 2); and
  - 2) a bezel member (16 in Fig. 2) mounted on the first end of the base member (16 mounted to 12 via 14 in Fig. 2) and defining a bezel opening (16 in Fig. 2);
  - 3) wherein at least one of a decorative embossment and a decorative cutout is defined in an outer surface of the base member (decorative spaces/cutouts between vertical segments 8 in Fig. 2); and
- b) a gemstone mounted in the gemstone mount assembly (Fig. 4) and captured between the base member and the bezel member (4 between 20 and 16),

wherein the gemstone is received in the base cavity (4 in 20 in Fig. 5) and extends through the base opening and the bezel opening (4 in Fig. 4).

As for Claim 34, Jenkins teaches of an article of decorative jewelry, Re: Claim 33, including a decorative embossment defined in an outer surface of the base member (decorative spaces between vertical segments 8 in Fig. 2).

As for Claim 35, Jenkins teaches of an article of decorative jewelry, Re: Claim 33, including a decorative cutout defined in an outer surface of the base member and communicates with the base cavity (decorative cutouts between vertical segments 8 in Fig. 2).

As for Claim 36, Jenkins teaches of an article of decorative jewelry comprising:

- a) a base member (12 in Fig. 2) defining a base cavity (inside of 12 in Fig. 2) and having first (12 in Fig. 2) and second opposed ends (8 in Fig. 2), the base member tapering from the first end to the second end (20 tapering downward in Fig. 3) and defining a base opening in the first end (12 in Fig. 2); and
- b) a bezel member (16 in Fig. 2) mounted on the first end of the base member (16 mounted to 12 via 14 in Fig. 2) and defining a bezel opening (16 in Fig. 2);
- c) wherein at least one of a decorative embossment and a decorative cutout is defined in an outer surface of the base member (decorative spaces/cutouts between vertical segments 8 in Fig. 2); and
- d) wherein the base member (12 in Fig. 2) and the bezel member (16 in Fig. 2) are adapted to capture the gemstone (Fig. 5) therebetween such that the gemstone

is received in the base cavity (4 in 20 in Fig. 5) and extends through the base opening and the bezel opening (4 in Fig. 4).

As for Claim 37, Jenkins teaches of an article of decorative jewelry, Re: Claim 36, including a decorative embossment defined in an outer surface of the base member (decorative spaces between vertical segments 8 in Fig. 2).

As for Claim 38, Jenkins teaches of an article of decorative jewelry, Re: Claim 36, including a decorative cutout defined in an outer surface of the base member and communicates with the base cavity (decorative cutouts between vertical segments 8 in Fig. 2).

**[4]** Claims 1, 14, 17, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson, US-2,811,024.

Thompson teaches of an article of decorative jewelry having means for successive temporary and permanent mounting of a platen.

As for Claim 1, Thompson teaches of an article of decorative jewelry comprising:

- a)
  - 1) a base member (9 in Fig. 2) defining a base cavity (inside of 9 in Fig. 2) and having first (9 in Fig. 2) and second opposed ends (7 in Fig. 2), the base member tapering from the first end to the second end (9 tapering toward 7 in Fig. 2) and defining a base opening in the first end (inside of 9 in Fig. 2); and

- 2) a bezel member (17 in Fig. 3) mounted on the first end of the base member (17 mounted to 9 via 21 and 20 in Figs. 2 and 3) and defining a bezel opening (16 in Fig. 3);
- 3) wherein the bezel member is bonded to the first end of the base member (17 mounted to 9 via 21 and 20 in Figs. 2 and 3); and

- b) a gemstone (15 in Fig. 3) mounted in the gemstone mount assembly (Fig. 3) and captured between the base member and the bezel member (Fig. 3 into Fig. 2), wherein the gemstone is received in the base cavity (Fig. 3 into Fig. 2, 14 in the cavity) and extends through the base opening and the bezel opening (extends outside of both 9 and the bezel opening 16 as shown in Figs. 3 into Fig. 2).

As for Claim 14, Thompson teaches of an article of decorative jewelry, Re: Claim 1, including a recess formed in a rear surface of the bezel member (20 in Fig. 3), wherein a portion of the first end of the base member is received in the recess (21 of 9 into 20 as shown in Figs. 3 into Fig. 2).

As for Claim 17, Thompson teaches of an assembly for use with a decorative stone comprising:

- a) a base member (9 in Fig. 2) defining a base cavity (inside of 9 in Fig. 2) and having first (9 in Fig. 2) and second opposed ends (7 in Fig. 2), the base member tapering from the first end to the second end (9 tapering toward 7 in Fig. 2) and defining a base opening in the first end (inside of 9 in Fig. 2); and

- b) a bezel member (17 in Fig. 3) mounted on the first end of the base member (17 mounted to 9 via 21 and 20 in Figs. 2 and 3) and defining a bezel opening (16 in Fig. 3);
- c) wherein the bezel member is bonded to the first end of the base member (17 mounted to 9 via 21 and 20 in Figs. 2 and 3); and
- d) wherein the base member (9 in Fig. 2) and the bezel member (17 in Fig. 3) are adapted to capture the gemstone (Fig. 3 into Fig. 2) therebetween such that the gemstone is received in the base cavity (Fig. 3 into Fig. 2, 14 in the cavity) and extends through the base opening and the bezel opening (extends outside of both 9 and the bezel opening 16 as shown in Figs. 3 into Fig. 2).

As for Claim 30, Thompson teaches of an article of decorative jewelry, Re: Claim 17, including a recess formed in a rear surface of the bezel member (20 in Fig. 3), wherein a portion of the first end of the base member is received in the recess (21 of 9 into 20 as shown in Figs. 3 into Fig. 2).

### ***Claim Rejections - 35 USC § 103***

**[5]** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[6] [Examiner's note concerning claims 2-6 (18-22) and 10-11 (26-27)]: claims 2-6 (18-22) and 10-11 are directed to a product-by-process claim wherein the process relied upon respectively: "welding, laser welding, soldered, adhered, a friction fit engagement, separately formed segments, and unitarily formed". This limitation is not given patentable weight since the structural limitations of the claimed product are met. That is, in the instant case, regardless of how the bezel member is attached to the base member, the structure that is being claimed remains the same, and thus, no patentable weight is given to the instant claims.

Concerning claims 2-6 (18-22), and 10-11 (26-27), the claimed structure matter appears to be met by the paragraph above, and therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See *In re Thorpe*, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

[7] Claims 15 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins, US-4,488,415.

Jenkins discloses the claimed invention except for an earring post in place of the ring at the second end of the base member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an additional design utilizing the gem setting for use with an earring, as it is readily known within the art that such settings are extremely commonplace within a variety necklaces, earrings,

rings, etc., as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

### ***Conclusion***

**[8]** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of assembly; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: Wertheimer et al., 5,375,434; Katz, US 2002/0083738; Czupor, 6,116,054; Pritchard, 2,239,302; Arpels, 2,069,598; Pilblad, 1,885,544; Gibeault, D189,758; Gebhardt, 954,568; Dover, 717,824; Coste, 1,032,116; Mesica, 4,936,115; Jenkins, 4,742,696; Meyer, 1,064,152; Dover, 722,824; Itzkowitz, D473,812; Gaertner, 2,200,841

**[9]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is 703-305-4805. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Examiner  
Art Unit 3677



ROBERT J. SANDY  
PRIMARY EXAMINER